



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/631,973

08/01/2003

Daniel Lee Hamilton

23952-0106

3676

72386

7590

07/10/2008

SUTHERLAND II

SUTHERLAND, ASBILL & BRENNAN, LLC

999 PEACHTREE STREET

ATLANTA, GA 30309

EXAMINER

NGUYEN, TIEN C

ART UNIT

PAPER NUMBER

3694

MAIL DATE

DELIVERY MODE

07/10/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/631,973	<b>Applicant(s)</b> HAMILTON ET AL.	
	<b>Examiner</b> TIEN C. NGUYEN	<b>Art Unit</b> 3694	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 April 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### DETAILED ACTION

1. The following is a Non-Final Office action in response to communications received on April 24, 2008. Claims 1-23 have been amended. Therefore, claims 1-23 are pending and addressed below.

#### ***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-12 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1-12 recite method directed to purely mental steps. In order for a method to be considered a "process" under §101, a claimed process must either: (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials). *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-788 (1876). If neither of these requirements is met by the claim, the method is not a patent eligible process under §101 and is non-statutory subject matter. Thus, to qualify as a statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied, for example, by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example, by identifying the material that is being changed to a different state.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. **Claims 1-11, and 13-22 are rejected under 35 U.S.C. 102(e) as being anticipated by Amalraj et al. (2004/0215560).**

**As per claim 1**, Amalraj teaches a method comprising:

receiving a payment request to pay a payee on behalf of a payor (paragraph [0005] discloses a consumer employs a payment requesting source to generate a payment request for transferring funds from the consumer to a biller to pay a bill.

Therefore, based on behalf of a consumer, a payment request has been generated to pay a bill to a biller. Paragraph [0055] discloses a payment request is received.

Therefore, receiving a payment request to pay a biller on behalf of a consumer);

Art Unit: 3694

determining an order of preferences (in order to generate a payment instruction from a payment request, the payment engine may determine the following preferences as an order of a flow chart diagram in Fig.11, paragraph 0028: 1) payment requesting source preferences, 2) Financial preferences, and 3) Operational preferences), wherein the preferences (via payment requesting source preferences, Fig.11) include at least two of a cost of processing preference (a bill payment with the lowest cost, paragraph 0028), a risk of processing preference (paragraph 0028), or a speed of processing preference;

evaluating a plurality of debit/credit combinations (evaluating and determining a funding account preferences, paragraph 0097 in Fig.11) based at least in part on a first preference in the order of preferences to determine a best debit/credit combination (Fig.11), wherein each of the plurality of debit/credit combinations is capable of effecting (capable of generating a payment instruction per a payment request, paragraph 0097 in Fig.11); and

effecting payment (Fig. 14) in accordance with the best debit/credit combination (funding account preferences is the best preferred or most optimum payment method, paragraphs 0099 and 0105).

**As per claim 2**, Amalraj teaches a method wherein the order of preferences is determined based upon at least one of the identity of the payor (paragraph 0029).

**As per claim 3**, Amalraj teaches a method wherein each of the preferences is associated with a priority, and further comprising:

Art Unit: 3694

identifying one of the preferences having a highest of the associated priorities (to process a payment request at element 224, requesting source references is identified having a highest of the associated priorities in a flow chart diagram, Fig. 11);

wherein the first preference in the order of preferences is the identified preference having the highest associated priority (to process a payment request at element 224, wherein the first requesting source references is identified having a highest of the associated priorities regarding a flow chart diagram, Fig. 11).

**As per claims 4 and 16,** Amalraj teaches a method and system wherein:

the payment request is received by a payment service provider (received by the integrated payment engine and the integrated payment engine employs profile information defining payment requesting source which include a payment service Provider, abstract and paragraph 0007); and

the associated priority of each of the preferences is determined by at least one of the payor (paragraph 0029).

**As per claims 5 and 17,** Amalraj teaches a method and system wherein:

if the payor (the payor associates with the payment method engine, Fig.3) determines the associated priority of a preference, the payor determines the associated priority of the speed of processing preference and the associated priority of the cost of processing preference, but not the associated priority of the risk of processing preference (operational preferences, paragraph 0098);

if a consumer service provider (a consumer service provider associates with the payment method engine, Fig.3) determines the associated priority of a preference, the

Art Unit: 3694

consumer service provider determines the associated priority of each of the speed of processing preference, cost of processing preference, and risk of processing preference (operational preferences, paragraph 0098 and financial risk preferences, Fig.11); and

if the payment service provider (the payment service provider associates with the payment method engine, Fig.3) determines the associated priority of a preference, the payment service provider determines the associated priority of each of the speed of processing preference , cost of processing preference, and risk of processing preference (operational preferences, paragraph 0098 and financial risk preferences, Fig.11).

**As per claims 6 and 18**, Amalraj teaches a method and system wherein the payment request is received by a payment service provider, and further comprising:

a processor configured (abstract) to determining if a consumer service provider associated with the payor (a consumer service provider associates with the payor and the payment method engine, Fig.3) has determined the associated priority of the preferences (paragraph 0097 and 0098);

wherein, if it is determined that the consumer service provider has determined the associated priority of each of the preferences (a consumer service provider associates with the payment method engine, Fig.3), the one identified preference processing is the preference processing having the highest priority as determined by the consumer service provider (to process a payment request at element 224, requesting source references is identified having a highest of the associated priorities in a flow chart diagram, Fig. 11); and

wherein, if it is determined that the consumer service provider has not determined the associated priority of each of the preferences, the one identified preference processing is the preference processing having the highest priority as determined by the payment service provider (whether or not that consumer service provider has not determined, in order to process a payment request at element 224, requesting source references is identified having a highest of the associated priorities in a flow chart diagram, Fig. 11).

**As per claims 7 and 19**, Amalraj teaches a method and system wherein the preferences at least two include the speed of processing preference, the cost of processing preference, and the risk of processing preference, and further comprising:

a processor configured (abstract) to determining if the payor (the payor associates with the payment method engine, Fig.3) has determined the associated priority of the speed of processing preference and the associated priority of cost of processing preference (operational preferences, paragraph 0098);

wherein, if it is determined that the consumer service provider has determined the associated priority of each processing preference and that the payor has determined the associated priority of the speed of processing preference and the cost of processing preference, the one identified preference processing is the preference processing having the highest associated priority as determined by at least one of the consumer service provider and the payor (to process a payment request at element 224, requesting source references is identified having a highest of the associated priorities in a flow chart diagram, Fig. 11); and



Art Unit: 3694

wherein, if it is determined that the consumer service provider has not determined the associated priority of each preference and that the payor has determined the associated priority of the speed of processing preference and the cost of processing preference, the one identified preference processing is the preference processing having the highest associated priority as determined by at least one of the payment service provider and the payor (to process a payment request at element 224, requesting source references is identified having a highest of the associated priorities in a flow chart diagram, Fig. 11).

**As per claims 8 and 20**, Amalraj teaches a method and system wherein each of the preferences at least two is associated with a priority, and further comprising:

a processor configured (abstract) to identifying one of the preferences having a highest of the associated priorities (to process a payment request at element 224, requesting source references is identified having a highest of the associated priorities in a flow chart diagram, Fig. 11);

determining those of a plurality of debit/credit combinations available to effect payment in accordance with the one identified preference processing (evaluating and determining a funding account preferences, paragraph 0097 in Fig.11); wherein, if only one of the plurality of debit/credit combinations is determined to be available, the first preference selected processing is the one identified preference processing and the payment is effected by the one debit/credit combination (paragraph 0100).

Art Unit: 3694

if only one of the plurality of debit/credit combinations is determined to be available, the first preference selected processing is the one identified preference and the payment is effected by the one debit/credit combination (paragraph 0100).

**As per claims 9 and 21**, Amalraj teaches a method and system wherein each of the plurality of debit/credit combinations is associated with a rank for each of the preferences at least two processing s, and further comprising:

a processor configured (abstract) to identifying one of the debit/credit combinations having a highest rank associated with the first preference, wherein the first preference has the highest priority of the preferences the one identified processing (Fig.11); and

wherein the best debit/credit combination is the one identified debit/credit combination (funding account preferences is the best preferred or most optimum payment method, paragraphs 0100 and 0105).

**As per claims 10 and 22**, Amalraj teaches a method and system wherein, each of the plurality of debit/credit combinations is associated with a rank for each of the preferences and wherein the plurality of debit/credit combinations is a first plurality of debit/credit combinations, wherein the first plurality of debit/credit combinations is a subset of a second plurality of debit/credit combinations (Fig. 11, paragraphs 0100 and 0105); and

if none of more the first plurality of debit/credit combinations is identified as having a highest rank associated with the first preference one identified processing having the highest priority, the best debit/credit combination is selected based on a

Art Unit: 3694

second preference in the order of preferences (funding account preferences is the best because there may only one transaction that contains both consumer debit and payee credit, paragraph 0100).

**As per claim 11**, Amalraj teaches a method further comprising:

selecting a form of payment based upon the best debit/credit combination selected (Fig. 14);

wherein the payment is effected in the selected form (Fig. 14).

**As per claim 13**, a system for comprising:

a communications interface configured to receive a payment request to pay a payee on behalf of a payor (paragraph 0007); and

a processor configured (abstract) to i) determining an order of preferences (in order to generate a payment instruction from a payment request, the payment engine may determine the following preferences as an order of a flow chart diagram in Fig.11, paragraph 0028: 1) payment requesting source preferences, 2) Financial preferences, and 3) Operational preferences), wherein the preferences (via payment requesting source preferences, Fig.11) include at least two of a cost of processing preference (a bill payment with the lowest cost, paragraph 0028), a risk of processing preference (paragraph 0028), or a speed of processing preference ii) evaluating a plurality of debit/credit combinations (evaluating and determining a funding account preferences, paragraph 0097 in Fig.11) based at least in part on a first preference in the order of preferences to determine a best debit/credit combination (Fig.11), wherein each of the plurality of debit/credit combinations is capable of effecting (capable of generating a payment instruction per a payment request, paragraph 0097 in Fig.11), and iii) to cause

Art Unit: 3694

payment to be effected in accordance with the best debit-credit combination (funding account preferences is the best preferred or most optimum payment method, paragraphs 0099 and 0105).

**As per claim 14**, Amalraj teaches a system wherein the plurality of debit/credit combinations to be evaluated are selected based upon at least one of the identity of the payor (paragraph 0029).

**As per claim 15**, Amalraj teaches a method wherein:

each of the preferences is associated with a priority (Fig.11);

a processor configured (abstract) to i) identifying one of the preferences having a highest of the associated priorities (to process a payment request at element 224, requesting source references is identified having a highest of the associated priorities in a flow chart diagram, Fig. 11);

wherein the first preference in the order of preferences is the identified preference having the highest associated priority (to process a payment request at element 224, wherein the first requesting source references is identified having a highest of the associated priorities regarding a flow chart diagram, Fig. 11).

**6. Claims 12 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Amalraj et al. (2004/0215560) in view of Embrey (2002/0032651).**

**As per claims 12**, Amalraj et al. teaches all the elements of the claim invention, but fail to explicitly teach a method wherein the selected form of payment is one of an electronic funds transfer drawn on a deposit account other than the payor deposit account.

Embrey teaches a method of the selected form of payment (via an electronic form or printed check form of each negotiable instrument; paragraph [0020]) is one of an electronic funds transfer drawn on a deposit account other than the payor deposit account (the negotiable instrument is one of the selected payment form of an electronic funds transfer to pull funds on deposit funds account; paragraph [0082]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify a method of Amalraj et al. to include a selected form of payment as taught by Embrey in order to provide the customization of payment formats for the users.

**As per claim 23**, Amalraj et al. teaches a system, wherein:

a processor configured (see paragraph [0038]) to i) select a form of payment based upon best debit/credit combination (selecting a form of payment based upon the payment requesting source in Fig.4; paragraphs [0061]), and ii) cause the payment is effected in the selected form (the actual bill payment is effected in the selected form in the payment requests 76; paragraph [0062]).

Amalraj et al. teaches all the elements of the claim invention, but fail to explicitly teach a system wherein the selected form of payment is one of an electronic funds transfer drawn on a deposit account other than the payor deposit account.

Embrey teaches a system of the selected form of payment (via an electronic form or printed check form of each negotiable instrument; paragraph [0020]) wherein one of an electronic funds transfer drawn on a deposit account other than the payor deposit

Art Unit: 3694

account (the negotiable instrument is one of the selected payment form of an electronic funds transfer to pull funds on deposit funds account; paragraph [0082]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify a system of Amalraj et al. to include a selected form of payment as taught by Embrey in order to provide the customization of payment formats for the users.

### ***Response to Arguments***

7. Applicant's arguments filed 04/24/08 have been fully considered but they are not persuasive. In the remarks, Applicant argues that Amalraj does not teach, suggest, or motivate, all the claim elements of amended independent Claim 1 and 13.

In response to argument, Examiner respectfully disagrees. Amalraj does teach, suggest, or motivate all the claim elements of amended independent Claim 1 and 13 that include:

determining an order of preferences (in order to generate a payment instruction from a payment request, the payment engine may determine the following preferences as an order of a flow chart diagram in Fig.11, paragraph 0028: 1) payment requesting source preferences, 2) Financial preferences, and 3) Operational preferences), wherein the preferences (via payment requesting source preferences, Fig.11) include at least two of a cost of processing preference (a bill payment with the lowest cost, paragraph 0028), a risk of processing preference (paragraph 0028), or a speed of processing preference;

Art Unit: 3694

evaluating a plurality of debit/credit combinations (evaluating and determining a funding account preferences, paragraph 0097 in Fig.11) based at least in part on a first preference in the order of preferences to determine a best debit/credit combination (Fig.11), wherein each of the plurality of debit/credit combinations is capable of effecting (capable of generating a payment instruction per a payment request, paragraph 0097 in Fig.11).

Therefore, Examiner maintains that Amalraj does teach and suggest this limitation and anticipate amended independent Claims 1 and 13.

### ***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Art Unit: 3694

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Tien Nguyen whose telephone number is (571) 270-5108. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammel can be reached on 571-273-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TN  
7/03/2008

/Mary Cheung/  
Primary Examiner, Art Unit 3694